UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,266	05/10/2001	Shunpei Yamazaki	12732-035001 / US4908	5445

26171   7590   05/05/2008
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
2162	

MAIL DATE	DELIVERY MODE
05/05/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/852,266	YAMAZAKI ET AL.
	Examiner	**Art Unit**	
	FRED I. EHICHIOYA	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 January 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11 - 17, 29, 30, 32, 33, 35, 36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 66, 67, and 70 - 81* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

Continuation of Disposition of Claims: Claims pending in the application are 11 - 17, 29, 30, 32, 33, 35, 36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 66, 67, and 70 - 81.

DETAILED ACTION

1.   This Office Action is responsive to communications filed January 18, 2008.

2.   Claims 11- 17, 29, 30, 32, 33, 35, 36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53,

54, 66, 67 and 70 – 81 are pending in this Office Action.

Response to Arguments

3.   Applicant's arguments regarding rejection of claims 11 – 17, 29, 30, 32, 33, 35,

36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 66 and 67 under 35 U.S.C. 101 have

been fully considered but are not persuasive

         Applicant argues:

         (a)   *For example, claim 11 recites "a storing means for storing reference living*

body information of the user" and claim 17 recites "a storing means for storing a plurality of

kinds of reference living body information of the user." Since these elements are written in

means-plus-function format, they must be interpreted to cover the structure set forth in the

specification for performing the storing function, or substantial equivalents thereof. At page

15, lines 3-5, the specification sets forth one example of the structure for storing the reference

living body information as being "a built-in memory of the authentication apparatus, such as

a non-volatile memory." Thus, the storing means must be interpreted to cover at least a non-

volatile memory (page 13).

         Firstly, Examiner submits that applicant did not claim apparatus, *"a built-in*

memory of the authentication apparatus, such as a non-volatile memory." is irrelevant in the

claimed limitations since applicant did not claim apparatus and secondly, though the

"elements are written in means-plus-function format, "means" is neither defined by the specification, drawings nor claims. Therefore, "means" itself would have reasonably been interpreted by one of ordinary skill as other than physical articles or objects to act as a hardware component and realize its functionality. As such, the claim is not limited to useful manufactures within the meaning of 35 USC 101, and therefore non-statutory.

(b)   Neither Uchida, Fakuzumi, the APA, nor any proper combination of the three describes or suggests sending a password for re-write as data to the mating party after the authentication end signal is sent to the mating part (claim 11) or the manager (claim 17) (page 14, paragraph 1).

Examiner respectfully disagrees with the applicants. APA (Applicant admitted prior art) discloses, "sending a password as a data to a mating party (or a manager) after authentication end signal is sent to the mating party (or manager) as shown on (Page 2, line 2 - 5); and further on page 3, lines 5 – 6 of the specification, APA discloses "the authentic person must ask the mating party, or often re-write the password". These pages and lines of the specification fairly suggest the APA disclosed applicant claimed limitation *"sending a password for re-write as data to the mating party after the authentication end signal is sent to the mating part".*

Drawings

4.   The replacement drawings were received on January 18, 2008. These drawings are accepted by the Examiner.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 – 17, 29, 30, 32, 33, 35, 36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 66 and 67 are rejected under 35 U.S.C. 101 because:

Claims 11 and 17 are directed to a "communication system"; Applicant discloses on page 2, lines 17 – 18 that the term "communication" means "transmission/reception of intended information"; this appears to be a carrier waves. Though the elements are written in means-plus-function format, "means" is neither defined by the specification, drawings nor claims. Therefore, "means" itself would have reasonably been interpreted by one of ordinary skill as other than physical articles or objects to act as a hardware component and realize its functionality. As such, the claims are not limited to useful manufactures within the meaning of 35 USC 101, and therefore non-statutory. (MPEP 2106.01 [R-5] (I)).

Regarding claims 16, 29, 32, 35, 38, 41, 44, 47, 50, 53, 66 and 30, 33, 36, 39, 42, 45, 48, 51, 54, 67; they depend from claims 11 and 17 respectively, recite computing steps, merely descriptive and lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101 and therefore non-statutory.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   Claims 11 – 17, 29, 30, 32, 33, 35, 36, 44, 45, 5, 51, 53, 54, 66, 67, and 70 - 81

are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Appl. No.

GB 2348309 issued to Kaoru Uchida (hereinafter "Uchida") in view of USPN 6,144,757

issued to Shinichi Fukuzumi et al (hereinafter "Fukuzumi") and further in view of

Applicant Admitted Prior Art (hereinafter "APA").

Regarding claims 11 and 17, Uchida teaches a communication system for

distinguishing a user, said system comprising:

a storing means for storing a plurality of kinds of reference living body information (see page 20, lines 13 – 17; Uchida discloses "fingerprint" as "living body");

Uchida does not explicitly collation and a collating means as claimed.

Fukuzumi discloses a reading means for reading a plurality of kinds of collating living body information of the user (column 9, lines 29 – 32: "bioelectric signal identification section" is interprets "unit 12" as "reading means"; and "output" is interpreted as "read"); and

collating means for collating the collation living body information with the stored corresponding reference living body information (column 6, lines 6 – 8);

Further, APA discloses a sending means for sending the authentication end signal to a mating party (see spec. page 2, lines 3 - 5);

wherein a password for re-write (see spec. page 3, lines 5 – 6: *the authentic person must ask the mating party, or often re-write the password"*) is sent as data to the mating party/manager after the authentication end signal is sent to a mating party (see spec. page 2, lines 11 – 13), and

wherein a re-write approval signal having information representing approval of re-write of the reference living body information is transmitted from the mating party when the password is authenticated as correct on the mating party (see spec. page 2, lines 11 – 16 "the mating party send a collation end signal representative of authentication approval/rejection as information as data to the user. . . . When the user is authenticate, the authentication operation is finished at the point when the user receives the collation end signal"), and

wherein the reference living body information is written after the user receives the re-write approval signal from the mating party (Applicant discloses on page 5, lines 15 – 17 that living body is re-written when password proves coincident; therefore, APA discloses re-writing living body information since it was discloses (see spec. page 2, lines 6 – 9) that "the user is authenticated when the password coincide")

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Fukuzumi's teaching of "collation" would have allowed Uchida's system to provide an organism identification method that can securely identify whether or not a fingerprint image input object relates to a living body.

Further, the teaching of APA would have allowed Uchida and Fukuzumi's system prevent a third party other than the authentic person from communicating as the user with mating party under the disguise of the authentic person as suggested by APA (spec. page 2, lines 20 – 25).

Regarding claim 12, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 11.

Uchida teaches a wherein the reference living body information comprises n reference living body information (see page 20, lines 13 – 17), and the sending means sends the authentication end signal to a mating party to the mating party when all of collation results prove coincident (see page 32, lines 13 - 16).

Further Fukuzumi discloses the collation living body information of the user comprises n collation living body information of the user (column 6, lines 29 – 32), the collating means collates the n collation living body information with the n reference living body information (page 8, lines 15 – 24).

Regarding claim 13, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 11.

Uchida teaches wherein the reference living body information comprises n reference living body information and the sending means sends the authentication end signal to a mating party (see page 32, lines 13 – 16) when at least one of the n reference living body information coincides with at least one of the m collation living body information (see page 21, lines 22 – 27);

Further Fukuzumi discloses the collation living body information of the user (column 6, lines 29 – 32), comprises in collation living body information of the user, the collating means collates the m collation living body information with the n reference living body information (column 7, lines 34 – 38).

Regarding claim 14, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 11.

Uchida teaches wherein the reference living body information comprises a plurality of kinds of reference living body information (page 22, lines 23 – 26), and the sending means sends (page 32, lines 13 - 16) the authentication end signal to the

mating party when the plurality of kinds of collation living body information wholly

coincide with the plurality of kinds of reference living body information (page 23, lines 5

– 10: Examiner interprets "input fingerprint is in accord with the fingerprint feature

stored" as "when all of collation results prove coincident");

Further Fukuzumi discloses the collation living body information of the user

comprises a plurality of kinds of collation living body information of the user (column 6,

lines 29 – 32), the collating means collates the plurality of kinds of collation living

information with a plurality of kinds of the reference living body information body

(column 7, lines 34 – 38).

Regarding claim 15, Uchida, Fukuzumi and APA disclose the claimed subject

matter as discussed in claim 11.

Uchida teaches wherein the reference living body information comprises n

reference living body information of a plurality of kinds (page 22, lines 23 – 26), and the

sending means sends (page 32, lines 13 - 16) the authentication end signal to a mating

party to the mating party when at least one of each kind of collation living body

information among the plurality of kinds of collation living body information coincides

with at least one of each kind of reference living body information among the n

reference living body information (see page 32, lines 13 – 16).

Further Fukuzumi discloses the collation living body information comprises in

collation living body information of a plurality of kinds of a user (column 6, lines 29 – 32),

the collating means collates the m collation living body information with the n reference

living body information (column 7, lines 34 – 38).

Regarding claim 16, Uchida, Fukuzumi and APA disclose the claimed subject

matter as discussed in claim 11.

Fukuzumi teaches wherein the reference living body information comprises n

reference living body information of a plurality of kinds, the collation living body

information comprises m collation living body information of a plurality of kinds of a user

(column 6, lines 29 – 32), the collating means collates the in collation living body

information with the n reference living body information (column 7, lines 34 – 38), and

the sending means sends the authentication end signal to a mating party (column 6,

lines 43 - 46) to the mating party when all of the plurality of kinds of collation living body

information coincide with all of the n reference living body information (column 6, lines29

- 32).

Regarding claim 29 and 30, Uchida teaches wherein the reference living body

information comprises at least two selected from the group consisting of a fingerprint, a

palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claims 32 and 33, Uchida teaches wherein the collation living body

information comprises at least two selected from the group consisting of a fingerprint, a

palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claim 35, 36, 53 and 54, Uchida teaches wherein the palm print is a

palm print of the whole palm or a palm print of a part of the palm (see page 35, lines 7 –

16).

Regarding claims 44 and 45, Uchida teaches a portable information terminal

comprising the storing means, the reading means, the collating means, the controlling

means, and the sending means is used (see page 35, lines 17 – 22).

Regarding claims 50 and 51, Uchida teaches a personal computer comprising

the storing means, the reading means, the collating means, the controlling means, and

the sending means is used (see pages 1 - 3).

Regarding claims 66 and 67, Uchida discloses wherein the reading means is a

display part having a built-in-sensor (page 18, lines 22 – 27).

Regarding claims 70 and 71, Uchida teaches a method for distinguishing a user,

said method comprising:

Storing a plurality of kinds of reference living body information of the user (see

page 20, lines 13 – 17; Uchida discloses "fingerprint" as "living body"); and

reading a plurality of kinds of collation living body information of the user (page

21, lines 17 - 19) so that the reference living body information is rewritten after the

receiving the re-write approval signal from the mating party (page 25, lines 7 – 8 – input

is interpreted as re-write)

Uchida does not explicitly collation as claimed.

Fukuzumi discloses reading collating living body information of the user a reading

means for reading collating living body information of the user (column 9, lines 29 – 32:

"bioelectric signal identification section" is interprets "unit 12" as "reading means"; and

"output" is interpreted as "read");

Collating the collation living body information with the stored corresponding

reference living body information (column 6, lines 6 – 8); and

outputting an authentication end signal from controlling means when a collation

result proves coincident (see column 7, lines 35 - 39);

Further, APA discloses sending the authentication end signal to a mating

party/manager (see spec. page 2, lines 3 - 5);

sending password for re-write (see spec. page 3, lines 5 – 6: *the authentic person*

must ask the mating party, or often re-write the password") as data to the mating

party/manager after communication is started (see spec. page 2, lines 11 – 13);

and the reference living body information is rewritten when the password is

authenticated as correct on the mating party (page 36, lines 6 - 9).

transmitting a re-write approval signal having information representing approval

of re-write of the reference living body from the mating party to the user when the

password is authenticated as correct on the mating party (see spec. page 2, lines 11 –

16 "the mating party send a collation end signal representative of authentication

approval/rejection as information as data to the user. . . . When the user is authenticate, the authentication operation is finished at the point when the user receives the collation end signal"), and

receiving the re-write approval signal from the mating party/manager (see page 2, lines 15 – 16 – "when the user receives the collation end signal, the communication is then started").

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Fukuzumi's teaching of "collation" would have allowed Uchida's system to provide an organism identification method that can securely identify whether or not a fingerprint image input object relates to a living body.

Further, the teaching of APA would have allowed Uchida and Fukuzumi's system prevent a third party other than the authentic person from communicating as the user with mating party under the disguise of the authentic person as suggested by APA (spec. page 2, lines 20 – 25).

Regarding claim 72, Uchida teaches a method for distinguishing a user, said method comprising:

storing reference living body information of the user (see page 20, lines 13 – 17; Uchida discloses "fingerprint" as "living body"); and

outputting an authentication end signal from controlling means (page 36, lines 7 – 9 and lines 18 – 20).

Uchida does not explicitly collation as claimed.

Fukuzumi discloses reading collating living body information of the user (column 9, lines 29 – 32: "output" is interpreted as "read");

collating the collation living body information with the stored reference living body information (column 6, lines 6 – 8).

Further APA discloses sending the authentication end signal to a manager (see spec. page 2, lines 4 – 5; "the user then transmits a password such as password number as data for authentication to the mating party" – mating party and manager are interchangeably used);

Sending the authentication end signal to a mating party (see spec. page 2,lines 13 – 14; "the user again transmits the password as the data to the mating party); and

wherein a communication between the user and the mating party is started directly through the manager after the mating party receives the authentication end signal (see spec. page 2, lines 2 – 8; APA discloses communication as transmission/reception page 2, lines 17- 18)

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Fukuzumi's teaching of "collation" would have allowed Uchida's system to provide an organism identification method that can securely identify whether or not a fingerprint image input object relates to a living body.

Further, the teaching of APA would have allowed Uchida and Fukuzumi's system prevent a third party other than the authentic person from communicating as the user

with mating party under the disguise of the authentic person as suggested by APA
(spec. page 2, lines 20 – 25).

Regarding claim 73, Uchida teaches wherein a communication between the user
and a mating party is started directly through the manager after the mating party
receives the authentication end signal (page 4, lines 19 - 20).

Regarding claims 74, Uchida discloses wherein the manager sends the
authentication end signal to the mating party after the manager receives the
authentication end signal (page 4, lines 27 – 52).

Regarding claim 75, Uchida discloses wherein the manager sends the
authentication end signal to the mating party after the manager receives the
authentication end signal (page 4, lines 27 – 52), and
    wherein a communication between the user and a mating party is directly after
the mating party receives the authentication end signal (page 4, lines 19 - 20).

Regarding claims 76, 77 and 78, Uchida discloses wherein a transaction is
conducted between the user and the mating party (page 4, lines 18 – 20), and
    Wherein an identification of the user is requested only when a condition set to the
mating party is satisfied (page 34, line 25 – page 35, line 5).

Regarding claims 79, 80 and 81, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 70, 71 and 72 respectively.

Uchida teaches wherein the reference living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16), and

wherein the collation living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

8.   Claims 38, 39, 41, 42, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Fukuzumi as discussed in independent claims 1, 7, 11, 17 and further in view of APA and USPN 6,219,793 issued to Yang Li et al (hereinafter "Li").

Regarding claims 38 and 39, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in 11 and 17 respectively. Uchida, Fukuzumi or APA does not explicitly teach a flash memory.

Li teaches the storing means is a flash memory (column 12, lines 20 – 27).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Li's teaching of "storing means is a flash memory" would have allowed Uchida, Fukuzumi and APA's system to involve the use of fingerprint matching to authenticate a

call or other communication over a wireless communication network as suggested by Li

at column 3, lines 10 - 12.

Regarding claims 41 and 42, Li teaches the reading means is a photodiode or a

charge coupled device (see column 4, lines 50 – 65).

Regarding claims 47 and 48, Li teaches a cellular telephone comprising storing

means, the reading means, collating means, the controlling means, and the sending

means is used (see column 4, lines 33 – 49).

Conclusion

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED I. EHICHIOYA whose telephone number is (571)272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fred I. Ehichioya/   /Shahid Al Alam/
Examiner Art Unit 2162   Primary Examiner, Art Unit 2162
May 6, 2008